

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK x

Case No. 07 cv 7456 (RMB)

BODUM USA, INC.,

Plaintiff,

ANSWER & COUNTERCLAIM

-against-

JURY TRIAL DEMANDED

EUROPEAN GIFT & HOUSEWARE,

Defendant.

x

For its Answer against Bodum USA, Inc. ("Bodum"), Defendant European Gift & Houseware ("EG&H") states as to the allegations of the Complaint:

1. Denied
2. Denied
3. Denied
4. Denied but admits that it has an office at 514 South 5th Avenue Mount Vernon, NY 10550.
5. Denied but admits that it sold coffee makers.
6. Denied
7. Denied
8. Denied
9. Denied
10. Denied
11. Denied

12. Denied
13. Denied
14. Denied
15. Denied
16. Denied
17. Denied
18. Denied
19. Denied
20. Denied
21. Denied
22. Denied
23. Denied
24. Denied
25. Denied
26. Denied
27. Denied
28. Denied
29. Denied
30. Denied
31. Denied
32. Denied

AFFIRMATIVE DEFENSES

- I. Failure to State a cause of action.
- II. EG&H does not and has never used chamboard as a name for its coffee makers.
- III. If Bodum had any rights in its alleged trade dress it has acquiesced in EG&H actions and has no right to enforce them.
- IV. If Bodum had any rights in its alleged trade dress it is estopped from enforcing them.
- V. If Bodum had any rights in its alleged trade dress it is prevented by laches from enforcing them.
- VI. If Bodum had any rights in its alleged trade dress it is prevented by waiver from enforcing them.
- VII. Bodum's alleged trade dress is merely descriptive, if not generic and not protectable.
- VIII. Bodum's alleged trade dress is functional and not enforceable.
- IX. Bodum's alleged trade dress lacks secondary meaning.
- X. Bodum's has failed to allege fraud with particularity.
- XI. Bodum's claims are pre-empted.
- XII. The statute of limitations has run on any claims of Bodum.
- XIII. Even though no one, not Bodum nor any of its affiliated entities has rights to the alleged trade dress, the present Bodum entity Bodum USA, Inc., is not the entity that has previously claimed such rights, that entity is either Bodum, Inc., a corporation of Pennsylvania doing business in Sturtevant Wisconsin (see Exhibit B) or Bodum AG a corporation of Switzerland doing business in San Diego, California, Peter Bodum A/S a

corporation of Denmark doing business in San Diego California, or Bodum Group, and Pi Design AG corporation of Switzerland doing business in San Diego, California, or Bodum (UK) Limited. Defendant reserves the right to dismiss the complaint and/or amend the answer and counterclaim to add these entities. - .

COUNTERCLAIM

THE PARTIES

1. On information and belief the Bodum entity in this lawsuit is a Delaware corporation having an office at 413-415 West 14th Street, New York 10014.
2. EG&H is a corporation of New York having and office at 514 South 5th Avenue, Mt. Vernon, New York 10550.

JURISDICTION & VENUE

3. The Court has jurisdiction of this counterclaim under the Federal Declaratory Judgment Act 28 USC 2201 et al and otherwise.
4. The Court has jurisdiction of the parties.
5. Venue is proper in this District.

FACTS COMMON TO ALL COUNTS

6. From at least 1990 EG&H has been engaged in the sales and advertising of coffee makers including the generic coffee maker as shown in EX. A.
7. EG&H has sold the generic coffee maker throughout the United

States.

8. During the time from 1990 to the present there have been numerous other companies advertising and selling these same generic coffee makers.

9. In or about August 25, 2000 Bodum, Inc. sent a letter to EG&H (Ex. B) stating its alleged rights and threatening suit on trade dress infringement.

10. On September 15, 2000 EG&H answered the letter denying liability (Ex. C).

11. From 2000 until this lawsuit (seven years) Bodum has taken no action on this claim against EG&H.

COUNT I
DECLARATORY JUDGMENT

12. EG&H restates and repeats paragraphs 1 to 11 as if stated herein.

13. Bodum has alleged it has trade dress rights in the generic shape of a coffee maker.

14. EG&H has been selling the generic coffee maker since at least 1990 long before Bodum began selling its coffee makers.

15. No one has any rights in the design of these coffee makers; a widely used generic design.

16. However even though no one has rights to the design of these coffee makers, EG&H has superior rights of priority to Bodum in the design of these coffee makers.

WHEREFORE, the Court should deny Plaintiff claims and find that:

a. The shape of these coffee makers is merely descriptive or generic and not protectable, and that no Bodum entity has any trade dress rights therein.

- b. Bodum's inaction against EG&H for 7 years resulted in no Bodum entity having rights against EG&H under the doctrines of acquiescence, waiver, laches and estoppel.
- c. Judgment against Bodum denying all of its claims with prejudice.
- d. Bodum take nothing from its complaint.
- e. EG&H be granted its costs and attorneys fees.
- f. A jury trial is demanded.

Dated: September 17, 2007

Respectfully submitted,

FELDMAN LAW GROUP, P.C.

By: 

Stephen E. Feldman (5630)
Paul J. Burgo (2706)

12 East 41st Street
New York, New York 10007
(212) 532-8585

Attorneys for Defendant
EUROPEAN GIFT & HOUSEWARE

EXHIBIT A

May 1991

European Gift & Houseware



102 SERIES: A new idea in espresso making! These black anodized pots are of a one piece construction, producing a stronger espresso brew. Made in Italy.

102B-3—Black aluminum 3 cup

102B-6—Black aluminum 6 cup

102B-9—Black aluminum 9 cup

FRENCH PRESS SERIES: Enjoy these beautifully crafted French press coffee makers for all types of coffee. Packaged in fitted styrofoam, and gift boxed. Replacement glass is available.

158—2 cup press (not shown)

159—4 cup press

162—6 cup press

163—8 cup press

888-4—This tea server with built in infusor is truly unique. 20 oz. capacity.

889-4—Tea server in chrome finish (not shown).

80—Set of three milk warmers. Stainless steel 5 oz., 12 oz., and 20 oz. Gift boxed

32—Stainless steel 8 oz. Gift boxed

34—Stainless steel 14 oz. Gift boxed

36—Stainless steel 28 oz. Gift boxed

Extra heavy S/S warmers are the highest quality available. 7mm thick and 18/10 construction, these are sold individually. Bakelite handles come fully attached and assembled.

41—Stainless steel 8 oz.

42—Stainless steel 12 oz.

43—Stainless steel 24 oz.

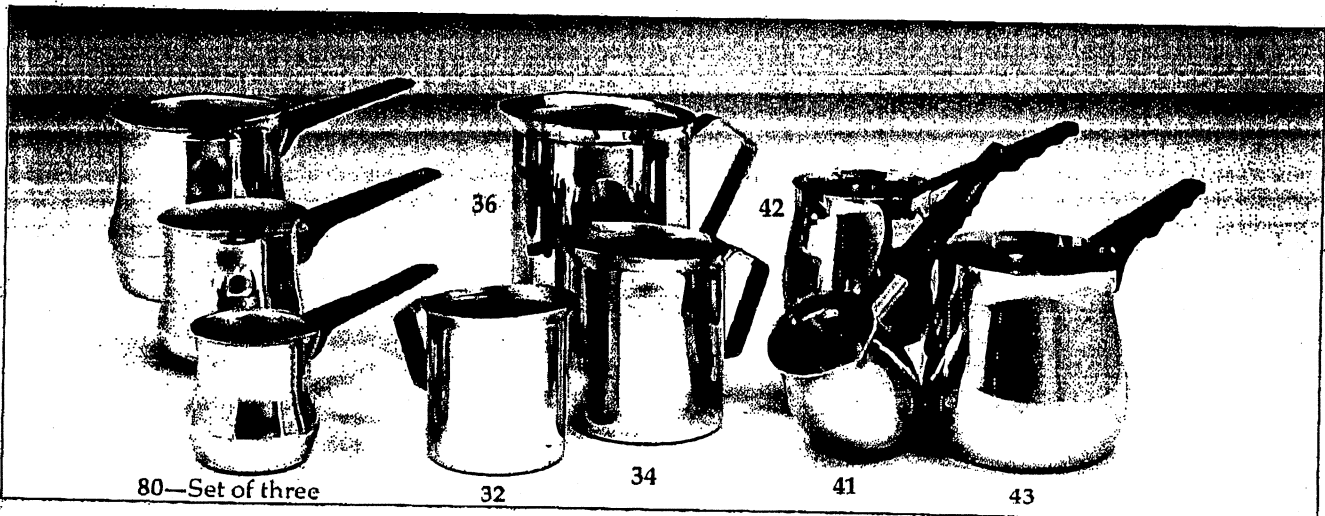
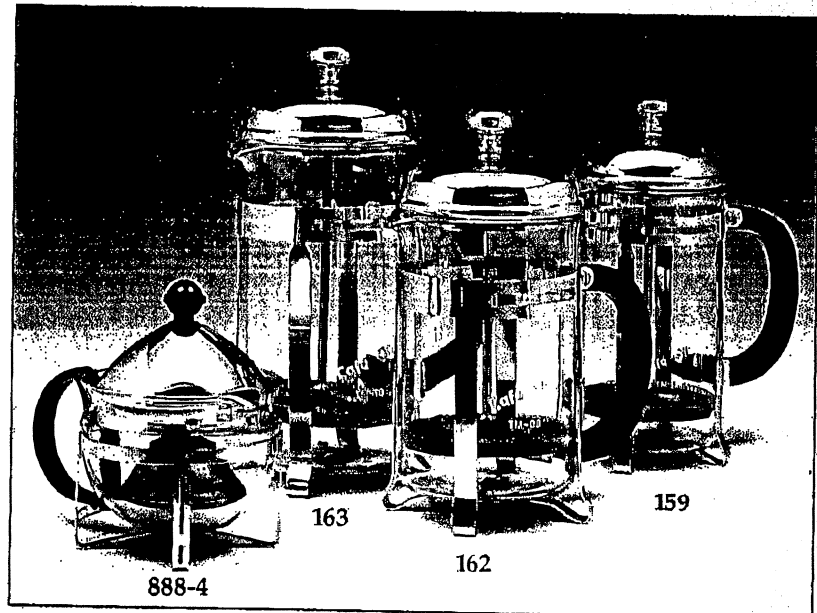


EXHIBIT B

VEDDER PRICE

THOMAS R. DEE
312-609-7746
tdee@vedderprice.com

VEDDER, PRICE, KAUFMAN & KAMMHOLZ
222 NORTH LASALLE STREET
CHICAGO, ILLINOIS 60601-1003
312-609-7500
FACSIMILE: 312-609-5005

A PARTNERSHIP INCLUDING VEDDER, PRICE, KAUFMAN & KAMMHOLZ, P.C.
WITH OFFICES IN CHICAGO AND NEW YORK CITY



August 25, 2000

VIA CERTIFIED MAIL -
Return Receipt Requested

European Gift & Houseware
514 South 5th Avenue
Mt. Vernon, NY 10550

Re: *Infringement of Bodum, Inc.'s Trade Dress*

Dear Sirs:

This Firm represents Bodum, Inc. of Sturtevant, Wisconsin and has been retained to take appropriate legal steps to protect our client's rights in the well-known trade dress of its Chambord plunger-type coffee maker. This trade dress is inherently distinctive and has been sold in the United States under the Bodum name since at least 1983. Bodum has spent considerable resources, time and effort in marketing, advertising and promoting its well-regarded Chambord trade dress throughout the United States. As a result of Bodum's considerable efforts, its trade dress is widely recognized throughout the United States, is the repository of substantial and valuable goodwill, and is one of Bodum's most valuable assets.

It has come to our attention that your Company is selling or offering for sale "knock-off" versions of Bodum's trade dress, a plunger type "Coffee and Tea Maker." Understandably, our client is concerned that European Gift & Houseware ("EG&H") is using its trade dress, and in doing so, is causing confusion, mistake and public deception in that consumers would believe that the infringing products are sponsored or approved by Bodum.

EG&H's use of Bodum's trade dress constitutes infringement, unfair competition and deceptive trade practices. If found liable under such claims, EG&H could be subjected to injunctive relief, a judgment for damages and claims for client's attorneys fees.

We are writing you at this time to give EG&H the opportunity to spare further legal and other expenses which may result from its continued unauthorized use of Bodum's trade dress. If we do not receive prompt written assurance that EG&H will agree to cease and desist permanently from

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VEDDER PRICE

European Gift & Houseware
August 25, 2000
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selling products which infringe on Bodum's trade dress, we will take appropriate legal measures to fully protect our client's interests. We are writing today because Bodum is desirous of reaching an amicable resolution of this matter that will protect the trade dress of its products.

Please let us know within seven (7) days of EG&H's willingness to comply with our request to cease and desist from the use of the trade dress and to resolve this matter in an amicable fashion.

Sincerely yours,



Thomas R. Dee

TRD/mg
Enclosures

cc: Brenda Cook, Bodum, Inc.
Carsten Jorgensen, Pi Design
Anna Birgitte Gammeljord

EXHIBIT C

LAW OFFICES

HALL DICKLER KENT GOLDSTEIN & WOOD LLP

909 THIRD AVENUE, NEW YORK, NY 10022-4731 -

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✱

September 15, 2000

BY FACSIMILE

Thomas R. Dee, Esq.
Vedder, Price, Kaufman & Kammholz
222 North LaSalle Street
Chicago, Illinois 60601-1003

Re: Bodum/European Gift & Houseware:
Alleged Trade Dress Infringement

Dear Mr. Dee:

This firm represents European Gift & Houseware ("EG&H") with respect to intellectual property matters and hereby responds to your August 25, 2000 letter.

You have alleged that your client, Bodum, Inc. ("Bodum") possesses protectible "trade dress" rights in the design of a particular coffee press -- marketed under the name CHAMBORD -- and further, that certain coffee presses sold by EG&H infringe upon this purported trade dress. You have failed, however, to provide any evidence or documentation supporting the assertion that the shape or design of the CHAMBORD coffee press functions as an indicator of source for Bodum or that Bodum has any enforceable rights therein.

Our preliminary investigation has revealed that (1) Bodum advertises and sells many different coffee presses of various shapes and designs (e.g., the SANTOS, EILEEN, KENYA and VERONA models); and (2) several parties other than Bodum sell

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TELEPHONE 914 683-3300 TELEFAX 914 428-1660

HALL DICKLER KENT GOLDSTEIN & WOOD LLP

Thomas R. Dee, Esq.
September 15, 2000
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coffee presses similar in design and appearance the CHAMBORD product. In light of these facts, it is difficult to see how the design of the CHAMBORD coffee press functions as a designator of source for your client. Moreover, the majority of the features of the CHAMBORD coffee press appear to be functional in nature, and thus, not protectible as trade dress. Indeed, you have not identified with any particularity those elements of the product which constitute the alleged trade dress of your client.

If you have any additional information or documentation which supports your assertions, please provide it to us and we will give the matter additional consideration. Short of that, however, we fail to see the merits of your claim.

Feel free to contact me with any comments or questions.

Very truly yours,

William M. Heberer

WMH:wmh

cc: Angelo Forzano

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